

	Complete if Known	
	Application No.	10/664,429
	Filing Date	September 16, 2003
	First Named Inventor	Christopher M. Glenna
	Group Art Unit	1772
	Examiner Name	N. Ahmad
Total Amount of Payment \$ 500.00		Atty. Docket Number 54093US010

<p style="text-align: center;">METHOD OF PAYMENT (Check One)</p> <p>1. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fee required under 37 C.F.R. 1.16 and 1.17 and credit any over payments to Deposit Account No.11-0982. Deposit Account Name: Kinney & Lange, P.A. A duplicate copy of this communication is enclosed.</p> <p>2. <input checked="" type="checkbox"/> Check Enclosed</p> <p style="text-align: center;">FEE CALCULATION</p> <p>1. BASIC FILING FEE</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Appn. Type</th> <th>FILING FEE FEE/SMALL</th> <th>SEARCH FEES FEE/SMALL</th> <th>EXAM FEES FEE/SMALL</th> <th>FEES</th> </tr> </thead> <tbody> <tr> <td>Utility</td> <td>300 / 150</td> <td>500 / 250</td> <td>200 / 100</td> <td>—</td> </tr> <tr> <td>Design</td> <td>200 / 100</td> <td>100 / 50</td> <td>130 / 65</td> <td>—</td> </tr> <tr> <td>Reissue</td> <td>300 / 150</td> <td>500 / 250</td> <td>600 / 300</td> <td>—</td> </tr> <tr> <td>Provisional</td> <td>200 / 100</td> <td>-0- / -0-</td> <td>-0- / -0-</td> <td>—</td> </tr> </tbody> </table> <p style="text-align: right;">Subtotal (1) \$-0-</p> <p>2. EXTRA CLAIM FEES</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th></th> <th>Number Claims</th> <th>Prior</th> <th>Extra</th> <th>Fee from Fee Paid Below</th> </tr> </thead> <tbody> <tr> <td>Total</td> <td>—</td> <td>—</td> <td>X</td> <td>—</td> </tr> <tr> <td>Indep.</td> <td>—</td> <td>—</td> <td>X</td> <td>—</td> </tr> <tr> <td>Multiple Dependent Claims</td> <td>—</td> <td>—</td> <td>—</td> <td>—</td> </tr> </tbody> </table> <p>Insert 3 and 20, or number previously paid if greater; Reissue see below</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Large Entity Fee Code</th> <th>Fee (\$)</th> <th>Small Entity Fee Code</th> <th>Fee (\$)</th> <th>Description</th> </tr> </thead> <tbody> <tr> <td>1202</td> <td>50</td> <td>2202</td> <td>25</td> <td>Claims in excess of 20</td> </tr> <tr> <td>1201</td> <td>200</td> <td>2201</td> <td>100</td> <td>Independent claims in excess of 3</td> </tr> <tr> <td>1203</td> <td>360</td> <td>2203</td> <td>180</td> <td>Multiple Dependent Claim</td> </tr> <tr> <td>1204</td> <td>200</td> <td>2204</td> <td>100</td> <td>Reissue Independent Claims Over Original Patent</td> </tr> <tr> <td>1205</td> <td>50</td> <td>2205</td> <td>25</td> <td>Reissue claims in excess of 20 and over original patent</td> </tr> </tbody> </table> <p>3. APPLICATION SIZE FEE If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 small) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 C.F.R. 1.16(s). <u>\$-0-</u></p> <p style="text-align: right;">Subtotal (2) \$-0-</p>	Appn. Type	FILING FEE FEE/SMALL	SEARCH FEES FEE/SMALL	EXAM FEES FEE/SMALL	FEES	Utility	300 / 150	500 / 250	200 / 100	—	Design	200 / 100	100 / 50	130 / 65	—	Reissue	300 / 150	500 / 250	600 / 300	—	Provisional	200 / 100	-0- / -0-	-0- / -0-	—		Number Claims	Prior	Extra	Fee from Fee Paid Below	Total	—	—	X	—	Indep.	—	—	X	—	Multiple Dependent Claims	—	—	—	—	Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Description	1202	50	2202	25	Claims in excess of 20	1201	200	2201	100	Independent claims in excess of 3	1203	360	2203	180	Multiple Dependent Claim	1204	200	2204	100	Reissue Independent Claims Over Original Patent	1205	50	2205	25	Reissue claims in excess of 20 and over original patent	<p style="text-align: center;">FEE CALCULATION (Continued)</p> <p>3. ADDITIONAL FEES</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Large Entity Fee Code</th> <th>Fee (\$)</th> <th>Small Entity Fee Code</th> <th>Fee (\$)</th> <th>Fee Description</th> <th>Fee paid</th> </tr> </thead> <tbody> <tr> <td>1051</td> <td>130</td> <td>2051</td> <td>65</td> <td>Surcharge - Late filing fee or oath</td> <td>—</td> </tr> <tr> <td>1052</td> <td>50</td> <td>2052</td> <td>25</td> <td>Surcharge - late provisional filing fee or cover sheet</td> <td>—</td> </tr> <tr> <td>1053</td> <td>130</td> <td>1053</td> <td>130</td> <td>Non-English specification</td> <td>—</td> </tr> <tr> <td>1812</td> <td>2,520</td> <td>1812</td> <td>2,520</td> <td>For Filing a Request for Reexamination</td> <td>—</td> </tr> <tr> <td>1251</td> <td>120</td> <td>2251</td> <td>60</td> <td>Extension for reply within first month</td> <td>—</td> </tr> <tr> <td>1252</td> <td>450</td> <td>2252</td> <td>225</td> <td>Extension for reply within second month</td> <td>—</td> </tr> <tr> <td>1253</td> <td>1,020</td> <td>2253</td> <td>510</td> <td>Extension for reply within third month</td> <td>—</td> </tr> <tr> <td>1254</td> <td>1,590</td> <td>2254</td> <td>795</td> <td>Extension for reply within fourth month</td> <td>—</td> </tr> <tr> <td>1255</td> <td>2,160</td> <td>2255</td> <td>1,080</td> <td>Extension for reply within fifth month</td> <td>—</td> </tr> <tr> <td>1402</td> <td>500</td> <td>2402</td> <td>250</td> <td>Filing a brief in support of an appeal</td> <td>500</td> </tr> <tr> <td>1403</td> <td>1,000</td> <td>2403</td> <td>500</td> <td>Request for oral hearing</td> <td>—</td> </tr> <tr> <td>1814</td> <td>130</td> <td>2814</td> <td>65</td> <td>Terminal Disclaimer Fee</td> <td>—</td> </tr> <tr> <td>1452</td> <td>500</td> <td>2452</td> <td>250</td> <td>Petition to revive - unavoidable</td> <td>—</td> </tr> <tr> <td>1453</td> <td>1,500</td> <td>2453</td> <td>750</td> <td>Petition to revive - unintentional</td> <td>—</td> </tr> <tr> <td>1501</td> <td>1,400</td> <td>2501</td> <td>700</td> <td>Utility/Reissue issue fee</td> <td>—</td> </tr> <tr> <td>1502</td> <td>800</td> <td>2502</td> <td>400</td> <td>Design issue fee</td> <td>—</td> </tr> <tr> <td>1460</td> <td>130</td> <td>1460</td> <td>130</td> <td>Petitions to the Commissioner</td> <td>—</td> </tr> <tr> <td>1807</td> <td>50</td> <td>1807</td> <td>50</td> <td>Petitions related to provisional applications</td> <td>—</td> </tr> <tr> <td>1806</td> <td>180</td> <td>1806</td> <td>180</td> <td>Submission of Information Disclosure Statement</td> <td>—</td> </tr> <tr> <td>8021</td> <td>40</td> <td>8021</td> <td>40</td> <td>Recording each patent assignment per property (times number of properties)</td> <td>—</td> </tr> <tr> <td>1801</td> <td>790</td> <td>2801</td> <td>395</td> <td>Request for Continued Examination (RCE)</td> <td>—</td> </tr> <tr> <td colspan="5">Other fee (specify) _____</td> <td>—</td> </tr> <tr> <td colspan="5" style="text-align: right;">Subtotal (3) \$500.00</td> </tr> </tbody> </table>	Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee paid	1051	130	2051	65	Surcharge - Late filing fee or oath	—	1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	—	1053	130	1053	130	Non-English specification	—	1812	2,520	1812	2,520	For Filing a Request for Reexamination	—	1251	120	2251	60	Extension for reply within first month	—	1252	450	2252	225	Extension for reply within second month	—	1253	1,020	2253	510	Extension for reply within third month	—	1254	1,590	2254	795	Extension for reply within fourth month	—	1255	2,160	2255	1,080	Extension for reply within fifth month	—	1402	500	2402	250	Filing a brief in support of an appeal	500	1403	1,000	2403	500	Request for oral hearing	—	1814	130	2814	65	Terminal Disclaimer Fee	—	1452	500	2452	250	Petition to revive - unavoidable	—	1453	1,500	2453	750	Petition to revive - unintentional	—	1501	1,400	2501	700	Utility/Reissue issue fee	—	1502	800	2502	400	Design issue fee	—	1460	130	1460	130	Petitions to the Commissioner	—	1807	50	1807	50	Petitions related to provisional applications	—	1806	180	1806	180	Submission of Information Disclosure Statement	—	8021	40	8021	40	Recording each patent assignment per property (times number of properties)	—	1801	790	2801	395	Request for Continued Examination (RCE)	—	Other fee (specify) _____					—	Subtotal (3) \$500.00				
Appn. Type	FILING FEE FEE/SMALL	SEARCH FEES FEE/SMALL	EXAM FEES FEE/SMALL	FEES																																																																																																																																																																																																																							
Utility	300 / 150	500 / 250	200 / 100	—																																																																																																																																																																																																																							
Design	200 / 100	100 / 50	130 / 65	—																																																																																																																																																																																																																							
Reissue	300 / 150	500 / 250	600 / 300	—																																																																																																																																																																																																																							
Provisional	200 / 100	-0- / -0-	-0- / -0-	—																																																																																																																																																																																																																							
	Number Claims	Prior	Extra	Fee from Fee Paid Below																																																																																																																																																																																																																							
Total	—	—	X	—																																																																																																																																																																																																																							
Indep.	—	—	X	—																																																																																																																																																																																																																							
Multiple Dependent Claims	—	—	—	—																																																																																																																																																																																																																							
Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Description																																																																																																																																																																																																																							
1202	50	2202	25	Claims in excess of 20																																																																																																																																																																																																																							
1201	200	2201	100	Independent claims in excess of 3																																																																																																																																																																																																																							
1203	360	2203	180	Multiple Dependent Claim																																																																																																																																																																																																																							
1204	200	2204	100	Reissue Independent Claims Over Original Patent																																																																																																																																																																																																																							
1205	50	2205	25	Reissue claims in excess of 20 and over original patent																																																																																																																																																																																																																							
Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee paid																																																																																																																																																																																																																						
1051	130	2051	65	Surcharge - Late filing fee or oath	—																																																																																																																																																																																																																						
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	—																																																																																																																																																																																																																						
1053	130	1053	130	Non-English specification	—																																																																																																																																																																																																																						
1812	2,520	1812	2,520	For Filing a Request for Reexamination	—																																																																																																																																																																																																																						
1251	120	2251	60	Extension for reply within first month	—																																																																																																																																																																																																																						
1252	450	2252	225	Extension for reply within second month	—																																																																																																																																																																																																																						
1253	1,020	2253	510	Extension for reply within third month	—																																																																																																																																																																																																																						
1254	1,590	2254	795	Extension for reply within fourth month	—																																																																																																																																																																																																																						
1255	2,160	2255	1,080	Extension for reply within fifth month	—																																																																																																																																																																																																																						
1402	500	2402	250	Filing a brief in support of an appeal	500																																																																																																																																																																																																																						
1403	1,000	2403	500	Request for oral hearing	—																																																																																																																																																																																																																						
1814	130	2814	65	Terminal Disclaimer Fee	—																																																																																																																																																																																																																						
1452	500	2452	250	Petition to revive - unavoidable	—																																																																																																																																																																																																																						
1453	1,500	2453	750	Petition to revive - unintentional	—																																																																																																																																																																																																																						
1501	1,400	2501	700	Utility/Reissue issue fee	—																																																																																																																																																																																																																						
1502	800	2502	400	Design issue fee	—																																																																																																																																																																																																																						
1460	130	1460	130	Petitions to the Commissioner	—																																																																																																																																																																																																																						
1807	50	1807	50	Petitions related to provisional applications	—																																																																																																																																																																																																																						
1806	180	1806	180	Submission of Information Disclosure Statement	—																																																																																																																																																																																																																						
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	—																																																																																																																																																																																																																						
1801	790	2801	395	Request for Continued Examination (RCE)	—																																																																																																																																																																																																																						
Other fee (specify) _____					—																																																																																																																																																																																																																						
Subtotal (3) \$500.00																																																																																																																																																																																																																											

Signature Alan M. Koenck Reg. No. 43,724

Date April 7, 2006 Deposit Account No. 11-0982



APR
2FW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor	: Christopher M. Glenna	Appeal No.
Appln. No.	: 10/664,429	
Filed	: September 16, 2003	Group Art Unit: 1772
Title	: TAPE ROLL TAB APPLICATION METHOD AND ARTICLE	Examiner: N. Ahmad
Docket No.	: 54093US010	

BRIEF FOR APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I CERTIFY THAT THIS PAPER IS BEING SENT BY U.S. MAIL, FIRST CLASS, TO THE ASSISTANT COMMISSIONER FOR PATENTS, ALEXANDRIA, VA 22313, THIS 7 DAY OF

April, 2006.

Ala. K. K.

PATENT ATTORNEY

This is an appeal from an Office Action dated January 3, 2006, in which claims 15-17 and 19-30 were finally rejected.

Real Party in Interest

The real party in interest is 3M Innovative Properties Company of St. Paul, Minnesota who is the owner of the entire right, title and interest in the application.

Related Appeals and Interferences

There are no known related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of the Claims

I. Total number of claims in the application

Claims in the application are: 1-30, inclusive.

II. Status of all the claims

A.	Claims cancelled:	1-14
B.	Claims withdrawn but not canceled:	none
C.	Claims pending:	15-30
D.	Claims allowed:	18
E.	Claims rejected:	15-17 and 19-30

III. Claims on appeal

- A. The claims on appeal are: 15-17 and 19-30.

Status of Amendments

No amendments have been made in response to the final Office Action dated January 3, 2006.

Summary of Invention

The present invention is a tape roll (20) that includes a central tape roll axis and a length of tape (22) circumferentially wound around the axis. The inward-facing side (26) of the tape is at least partially covered with pressure sensitive adhesive. The tape roll also includes a tab (32) having an inward-facing side (38) that has a portion covered with pressure sensitive adhesive. The adhesive portion of the inward-facing side of the tab is adhered to the outward-facing side (24) of the tape on a penultimate layer of the roll, so that the trailing end (34) of the tape overlays the tab between its ends. See, e.g., FIG. 3a.

Description of References Relied on by the Examiner

Dills (U.S. Patent No. 4,512,462) discloses a tape roll (22) having a removable, reusable tab (10) with an opening (18). A portion of the tape (20) projects through the opening (18) of the tape roll (22) and is readhered to the roll. See FIGS. 2 and 3 and the description at column 2, lines 49-66. The tab (10) does not have adhesive on either of its sides, but instead relies on the

adhesive of the tape (20) that projects through the opening (18) to adhere the tape (20) and tab (18) together to the tape roll (22).

Hammond (U.S. Patent No. 2,015,268) discloses a tape roll having a tab strip (c) having adhesive on an inward-facing side so that it is adhered to the tape roll coil (e). The tab strip (c) also has a plurality of holes punched in it, to reduce the level of adhesion between the tape (b) and the tab strip (c). See FIG. 1 and the description on the right-hand column of page 1, lines 20-53. The tape (b) overlays all of the tab strip (c), so that no portion of the tab strip (c) is exposed. This configuration is shown in FIG. 1 of the instant application, described as "overtabbing" which is known in the art (and the problems of which are described in the background portion of the instant application).

Golub (U.S. Patent No. 2,329,527) discloses a roll of tape (10) that includes a sealing strip or tab (13) that has adhesive on its surfaces. The tape overlays the entire tab in an "overtabbing" configuration.

Copies of the above-noted references are provided in Appendix B.

Issues

Whether it is proper to modify the teachings of Dills with the teachings of Hammond in the manner recited by the claims of the instant application.

Whether the combination of teachings of Dills and Hammond discloses all of the elements recited by the claims of the instant application.

Grouping of Claims

The following groupings of claims are made solely in the interest of consolidating issues and expediting this Appeal. No grouping of claims is intended to be nor should be interpreted as being any form of admission or a statement as to the scope or obviousness of any limitations.

Claims 15 and 21-30 stand and fall together.

Claims 16, 17, 19 and 20 stand and fall together.

Argument

Independent claim 15

Independent claim 15 recites a tape roll that includes a central tape roll axis and a length of tape circumferentially wound about the axis, the tape having first and second sides. The second side (which faces inward, toward the axis) is at least partially covered with pressure sensitive adhesive. The tape roll also includes a tab having first and second sides. At least a portion of the second side of the tab is covered with pressure sensitive adhesive. The adhesive portion of the second side of the tab is adhered to the first side of the tape on a penultimate layer of the roll, so that the trailing end of the tape overlays the tab between first and second ends of the tab.

The Examiner rejected independent claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Dills (USP 4,512,462) in view of Hammond (USP 2,015,268). The Examiner contended that Dills discloses all of the elements of the claim except that the tab has an adhesive section on its second side which is adhered to the first side of the tape. The Examiner turned to the teachings of Hammond to supply this deficiency, contending that "Hammond shows that providing adhesive on a tab with [a] hole or without [a] hole, including adhesive and non-adhesive portions, are equivalent structure[s] known in the art. Therefore, because these two adhesive tabs with holes and ... without holes were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute Hammond's adhesive tab without holes for Dills' tab with at least one hole."

Dills discloses a tape roll (22) having a removable, reusable tab (10) with an opening (18). A portion of the tape (20) projects through the opening (18) of the tape roll (22) and is readhered to the roll. See FIGS. 2 and 3 and the description at column 2, lines 49-66. The tab (10) does not have adhesive on either of its sides, but instead relies on the adhesive of the tape (20) that projects through the opening (18) to adhere the tape (20) and tab (18) together to the tape roll (22). Hammond discloses a tape roll having a tab strip (c) having adhesive on one side so that it is adhered to the tape roll coil (e). The tab strip (c) also has a plurality of holes punched in it, to reduce the level of adhesion between the tape (b) and the tab strip (c). See FIG. 1 and the description on the

right-hand column of page 1, lines 20-53. The tape (b) overlays all of the tab strip (c), so that no portion of the tab strip (c) is exposed. This configuration is shown in FIG. 1 of the instant application, described as "overtabbing" which is known in the art (and the problems of which are described in the background portion of the instant application).

The Examiner has proposed a combination of Dills and Hammond, contending that this combination renders obvious the subject matter recited by independent claim 15. In order to reject a claim as being obvious over a combination of references, three basic requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See M.P.E.P. 2143.

It is well established that the "factual inquiry whether to combine references must be thorough and searching" (In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002)) and that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed". In re Rouffet, 149 F.3d 1350, 1359 (Fed. Cir. 1998). "The examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" In re Lee at 1343 (citing In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992)). But when looking to the general knowledge of those skilled in the art, the Federal Circuit has recently reminded us of its "skepticism about invoking the knowledge of a skilled artisan to supply the motivation to combine on a scanty record." Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1348 (Fed. Cir. 2005) (citing In re Lee at 1343-44). This emphasis on specificity is intended to avoid an impermissible hindsight-based obviousness determination. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

In the present case, there is no teaching or suggestion to combine the references cited by the Examiner in the manner recited by claim 15; the only motivation to combine these references is provided by the Applicant's disclosure. The Examiner proposes modifying the tab (10) of Dills to include an adhesive portion for securing the tab to the tape roll (22), along the lines taught by Hammond. However, this modification would render useless the opening (18) in the tab (10) that is taught by Dills to be provided explicitly for the purpose of sticking the tab (10) to the roll (22). See column 3, lines 7-10. Because Dills already teaches a structure designed to provide adherence to the tape roll (via the tape projecting through an opening), one skilled in the art would have no motivation to modify the teachings of Dill to provide adhesive on the tab itself for adherence to the tape roll.

The Examiner has not provided any specific motivation from the prior art of record that would suggest the proposed modification of Dills, as is required to support such a modification (see discussion of In re Lee above). Instead, the Examiner has simply stated that Hammond "shows that providing adhesive on a tab with hole or without hole, including adhesive and non-adhesive portions, are equivalent structure known in the art. Therefore, because these two adhesive tabs with holes and adhesive tab without holes were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute Hammond's adhesive tab without holes for Dills' tab with at least one hole." See Office Action dated July 7, 2005, page 3; see also Office Action dated January 3, 2006, pages 2-3.

There are two problems with the Examiner's proposed modification. First, the requisite motivation to modify Dills in the manner suggested is lacking, and no reference to the record has been made to support this modification. The Examiner points to the teachings of Hammond as disclosing an "adhesive tape tab comprising an adhesive strip (c) with perforations (d) in figure-3" and notes that "[i]n figure-2, Hammond teaches that the tab has adhesive portions (g) and adhesive deadened portions (f)." See Office Action dated July 7, 2005, page 3; see also Office Action dated January 3, 2006, pages 2-3. These teachings do not provide any suggestion to modify the tab configuration of Dills, which includes a hole so that the tape projecting through the hole will adhere to the non-adhesive surface of the previously wound layer of tape. By contrast, these

teachings of Hammond are intended only to instruct one skilled in the art how to reduce the level of adhesion of the tab, by making the adhesive on the tab non-continuous. See Hammond, column 2, lines 29-38. Dills already teaches that the adhesion to the previously wound layer of tape is achieved by the tape projecting through a hole, and thus Dills has no reason to utilize the teachings of Hammond. No evidence on the record supports a motivation to modify Dills to include adhesive as claimed, and therefore the combination of Dills and Hammond is improper and the rejection of claim 15 under 35 U.S.C. § 103(a) should be withdrawn.

Second, the Examiner's contention of art-known equivalency is misapplied to the rejection of claim 15. In order to reject claim 15, the Examiner has combined all of the teachings of Dills with one particular teaching of Hammond (a tab having adhesive and non-adhesive portions), but no other teaching of Hammond (such as the overtabbing configuration in which no portion of the tab is left exposed). The Examiner is not suggesting to substitute the tab of Hammond for the tab of Dills, because such a substitution would not disclose all of the elements of claim 15. Instead, the Examiner seeks to only substitute the teaching of Hammond that the tab has an adhesive portion for the teaching of Dills that the tab has no adhesive. However, as discussed above, one skilled in the art would have no motivation to substitute this particular teaching from Hammond for the teaching of Dills, as the Dills tab is configured to include a hole through which the adhesive side of the tape causes the tape to adhere to the roll. No specific evidence is offered for the proposition that this specific teaching of Hammond (but not the other teachings of Hammond) would be used by one skilled in the art to modify the teachings of Dills. Because the requisite suggestion or motivation to combine the teachings of Dills and Hammond in the manner recited in claim 15 is lacking, the combination of these references is not proper, and the rejection of claim 15 under 35 U.S.C. § 103(a) should accordingly be withdrawn.

Further evidence that a proposed combination of references would not have been obvious to one of ordinary skill in the art is found in the teachings of Dills, which specifically notes the difficulties associated with markers/tabs for marking the end of a tape that adhere to the tape (such a marker "destroys that portion (of the tape) to which it is adhered"). See column 1, lines 22-

29. It is improper to combine references where the references teach away from their combination. M.P.E.P. 2145(X)(D)(2), citing In re Grasselli, 218 U.S.P.Q. (BNA) 769, 779 (Fed. Cir. 1983). In this case, the proposed combination of Dills and Hammond would require a skilled artisan to modify the tab disclosed by Dills to include adhesive as disclosed by Hammond, in spite of the fact that the Dills patent specifically discloses a tab without adhesive and notes the problems associated with tabs in the prior art that were adhered to the tape. In view of the contrary teachings of Dills, it would not have been obvious to modify the Dills tab to include adhesive as taught by Hammond, and the rejection of claim 15 under 35 U.S.C. § 103(a) should accordingly be withdrawn.

Dependent claims 16, 17 and 20

The Examiner also rejected dependent claims 16, 17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond. Dependent claim 16 recites that the second side of the tab comprises a non-adhesive portion having first and second ends, the first end of the non-adhesive portion coinciding with the first end of the tab. The adhesive portion of the second side of the tab has first and second ends, the first end of the adhesive portion being located adjacent to the second end of the non-adhesive portion, and the second end of the adhesive portion coinciding with the second end of the tab. An example of this configuration is shown in FIG. 3a of the instant application. The Examiner pointed to the adhesive portions (g) and the adhesive deadened portions (f) shown in Fig. 2 of Hammond as disclosing the elements of claim 16. However, claim 16 is not disclosed by the combination of Dills and Hammond. Dills teaches no adhesive on the tab. Hammond teaches adhesive portions (g) and non-adhesive portions (f) that are interspersed with one another. The adhesive and non-adhesive portions disclosed by Hammond do not satisfy the spatial recitations of amended claim 16. Specifically, claim 16 recites that the non-adhesive portion of the tab has first and second ends, that the adhesive portion of the tab has first and second ends, and that (a) the first end of the non-adhesive portion coincides with the first end of the tab, (b) the second end of the adhesive portion coincides with the second end of the tab, and (c) the first end of the adhesive portion is located adjacent to the second end of the non-adhesive portion. This configuration is

illustrated in FIG. 3a, for example, where tab 32 includes non-adhesive portion 40 and adhesive portion 42, with non-adhesive portion 40 having an exterior end that coincides with one end of tab 32, adhesive portion 42 having an exterior end that coincides with the other end of tab 32, and the interior ends of non-adhesive portion 40 and adhesive portion 42 being located adjacent to one another.

The Examiner contended in the Office Action dated January 3, 2006 that “Hammond clearly shows that a first end of the adhesive (c or g) is located adjacent to non-adhesive portion (d or f) and the second end of the adhesive portion coincides with the edge of the tab as shown in figures 2-3 and 5.” The Applicant disagrees with this contention, as Figures 2, 3 and 5 of Hammond show adhesive portions that are all spaced from the ends of the tab; that is, no end of the adhesive portions (c or g) coincide with an end of the tab, as is recited in claim 16. Because the combination of Dills and Hammond fails to disclose all of the elements of claim 16 (and also because claim 16 depends from allowable independent claim 15), the rejection of claim 16 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 17 and 20 depend from claim 16, and are allowable therewith.

Dependent claims 21-25 and 27-30

The Examiner also rejected dependent claims 21-25 and 27-30 under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond. Claims 21-25 and 27-30 depend from independent claim 15, and are allowable therewith.

Dependent claims 19 and 26

Claims 19 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond and Golub (USP 2,329,527). Claims 19 and 26 depend from independent claim 15, and are allowable therewith.

First Named Inventor: Christopher M. Glenna

Appln. No.: 10/664,429

-10-

CONCLUSION

In view of the foregoing, the rejections of all of the claims on appeal (15-17 and 19-30) should be withdrawn.

Respectfully submitted,

KINNEY & LANGE, P.A.

By: _____



Alan M. Koenck, Reg. No. 43,724

THE KINNEY & LANGE BUILDING

312 South 3rd Street

Minneapolis, MN 55402-1002

Telephone: (612) 339-1863

Fax: (612) 339-6580

AMK

Appendix A
Listing of Claims

15. A tape roll comprising:
- a central tape roll axis;
- a length of tape comprising a leading end, a trailing end opposite the leading end, a first side, and a second side opposite the first side, wherein the second side of the tape is at least partially covered with pressure sensitive adhesive, and wherein the tape is circumferentially wound about the axis until a plurality of adjacent tape layers are wound; and
- a tab having first and second opposite ends, a first side, and a second side opposite the first side, wherein at least a portion of the second side of the tab is covered with pressure sensitive adhesive;
- wherein the adhesive portion of the second side of the tab is adhered to the first side of the tape on a penultimate layer of the roll so that the trailing end of the tape overlays the tab between the first and second ends of the tab.
16. The tape roll of claim 15, wherein the second side of the tab comprises:
- a non-adhesive portion having first and second ends, the first end of the non-adhesive portion coinciding with the first end of the tab; and
- the adhesive portion of the second side of the tab having first and second ends, the first end of the adhesive portion being located adjacent to the second end of the non-adhesive portion, and the second end of the adhesive portion coinciding with the second end of the tab.

17. The tape roll of claim 16, wherein the tab comprises a deadening layer to provide the non-adhesive portion of the tab.

18. The tape roll of claim 16, wherein the tab comprises at least a portion of the adhesive portion of the second side of the tab folded toward and adhered to the second side of the tab to provide the non-adhesive tab portion.

19. The tape roll of claim 16, wherein the tap comprises a web material laminated to at least a portion of the adhesive on the second side of the tab to provide the non-adhesive tab portion.

20. The tape roll of claim 16, wherein the trailing end of the tape overlays both the adhesive and non-adhesive portions of the tab.

21. The tape roll of claim 15, wherein the adhesive portion of the tab is spaced from the trailing end of the tape by a distance that is at least as long as a circumference of the penultimate layer of the roll and is no longer than a total distance of the circumference of the penultimate layer and a length of the tab.

22. The tape roll of claim 15, wherein the adhesive on the second side of the tab has the same adhesive strength as the adhesive on the second side of the length of tape.

23. The tape roll of claim 15, wherein the adhesive on the second side of the tab has greater adhesive strength than the adhesive on the second side of the length of tape.

24. The tape roll of claim 15, wherein the adhesive on the second side of the tab has less adhesive strength than the adhesive on the second side of the length of tape.

25. The tape roll of claim 15, wherein the adhesive on the second side of the tab is a repositionable pressure sensitive adhesive.

26. The tape roll of claim 15, wherein the entire second side of the tab is coated with pressure sensitive adhesive.

27. The tape roll of claim 15, further comprising a tape core defining the central tape roll axis, wherein the length of tape is circumferentially wound about the core.

28. The tape roll of claim 15, wherein the length of tape has a width, the tab has a width, and the width of the length of tape is approximately equal to the width of the tab.

29. The tape roll of claim 15, wherein the tab is generally transparent across its length and width.

First Named Inventor: Christopher M. Glenna

Appln. No.: 10/664,429

-14-

30. The tape roll of claim 15, wherein at least a portion of the tab is opaque or translucent.

Appendix B ****

[List references cited – copies attached]

Dills (U.S. Patent No. 4,512,462)

Hammond (U.S. Patent No. 2,015,268)

Golub (U.S. Patent No. 2,329,527)

Appendix C ****

[Table of Cases]

In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002)

In re Rouffet, 149 F.3d 1350, 1359 (Fed. Cir. 1998)

In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992)

Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1348 (Fed. Cir. 2005)

In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999)

In re Grasselli, 218 U.S.P.Q. (BNA) 769, 779 (Fed. Cir. 1983).